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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,114	11/13/2003	Yuuji Kitamura	R2184.0270/P270	7707
24998 7590 08/01/2008 DICKSTEIN SHAPIRO LLP 1825 EYE STREET NW Washington, DC 20006-5403				
EXAMINER				
ALUNKAL, THOMAS D				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/706,114

**Applicant(s)**

KITAMURA, YUUJI

**Examiner**

THOMAS D. ALUNKAL

**Art Unit**

2627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 May 2008.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 3, 5, 6, 8, 10, 11, 13, 15, 16, 18 and 20-26 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☒ Claim(s) 1, 3, 5, 6, 8, 10, 11, 16, 18 and 20-26 is/are allowed.  
6) ☒ Claim(s) 13 and 15 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 13 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/19/08 has been entered.

***Response to Arguments***

Applicant's arguments, see Remarks, filed 3/20/08, with respect to the prior art rejections of claims 1, 3, 5-6, 8, 10-11, 13, 15-16, 18, and 20-26 have been fully considered and are persuasive. The previous grounds of rejection have been withdrawn.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 13 and 15 are drawn to a "program" *per se* or non-tangible signal with "program", *per se*, or non-tangible computer readable medium with "program", *per se*, as recited in the preamble and as such is non-statutory subject matter. See MPEP § 2106.01. Data structures not claimed as embodied in tangible computer readable

media are descriptive material *per se* and are not statutory because they are not capable of causing functional change in the computer. See, e.g., *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure *per se* held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention, which permit the data structure's functionality to be realized. In contrast, a claimed tangible computer readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory. Similarly, computer programs claimed as computer listings *per se*, i.e., the descriptions or expressions of the programs are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer, which permit the computer program's functionality to be realized. Specifically, the "computer program" of claims 13 and 15 is not claimed as embodied in a tangible computer readable media.

***Allowable Subject Matter***

Claims 1, 3, 5-6, 8, 10-11, 16, 18, and 20-26 are allowed.

The prior art (see cited references) taken either singularly or in combination fails to anticipate or fairly suggest the limitations of the independent claims, 1, 3, 6, 8, 11, 16,

18, 23, and 24, in such a manner that a rejection under 35. U.S.C 102 or 103 would be proper.

Regarding claim 1, the prior art taken either singularly or in combination fails to anticipate or fairly suggest a medium judgment method which determines authorization of a rewritable storage medium having a read-only area and a rewritable area for use in an optical disk drive, the method comprising steps of: acquiring a specific information of the medium from an information reproduction area of the read-only area of the medium; determining whether contents of the medium are authorized based on the acquired specific information; permitting running of a starting process of the optical disk drive with the medium when the authorization of the medium is determined as being correct; and inhibiting running of the starting process of the optical disk drive with the medium when the authorization of the medium is determined as being incorrect, and ***wherein the method is used to read the rewritable storage medium in a read-only optical disk drive which cannot acquire the specific information from the medium, such that acquisition of the specific information from the medium is impossible, such that a request to acquire the specific information from the medium during the acquiring step causes the read-only optical disc drive to generate error information, and wherein the medium is determined to be authorized based on the error information.***

Regarding claim 3, the prior art taken either singularly or in combination fails to anticipate or fairly suggest a medium judgment method which determines authorization of a rewritable storage medium having a read-only area and a rewritable area for use in

a read-only optical disk drive, the method comprising steps of: acquiring a first specific information of the medium from a wobbling groove of the medium; acquiring a second specific information of the medium from an information reproduction area of the read-only area of the medium, the second specific information being pre-recorded in the information reproduction area when the first specific information is copied; determining whether contents of the medium are authorized based on both the acquired first specific information and the acquired second specific information; permitting running of a starting process of the optical disc drive with the medium when the authorization of the medium is determined as being correct; and inhibiting running of the starting process of the optical disc drive with the medium when the authorization of the medium is determined as being incorrect, ***wherein when the acquisition of the first specific information from the medium is impossible, such that a request for acquisition of the first specific information causes error information to be generated, and when the acquisition of the second specific information from the medium is possible, the medium is determined to be authorized based on both the error information and the acquired second specific information.***

Regarding claim 6, claim 6 is drawn to the computer-readable storage medium storing a program that causes a computer to execute the medium judgment method of claim 1. Therefore, claim 6 contains limitations substantially similar to the limitations of claim 1 and is allowed for the same reasons.

Regarding claim 8, claim 8 is drawn to the computer-readable storage medium storing a program that causes a computer to execute the medium judgment method of

claim 3. Therefore, claim 8 contains limitations substantially similar to the limitations of claim 3 and is allowed for the same reasons.

Regarding claim 11, the prior art taken either singularly or in combination fails to anticipate or fairly suggest a medium judgment computer program stored on a computer-readable storage medium for causing a computer to execute a medium judgment method which determines authorization of a rewritable storage medium having a read-only area and a rewritable area for use in a read-only optical disk drive, the method comprising steps of: acquiring a specific information of the medium from an information reproduction area of the read-only area of the medium; determining whether contents of the medium are authorized based on the acquired specific information; permitting running of a starting process of the optical disk drive with the medium when the authorization of the medium is determined as being correct; and inhibiting running of the starting process of the optical disk drive with the medium when the authorization of the medium is determined as being incorrect, ***wherein when the acquisition of the specific information from the medium is impossible, such that a request to acquire the specific information from the medium during the acquiring step causes the drive to generate error information , the medium is determined to be authorized based on the error information.***

Regarding claim 16, claim 16 is drawn to the optical disk drive corresponding to the method of using the same in claim 1. Therefore, claim 16 contains limitations substantially similar to the limitations of claim 1 and is allowed for the same reasons.

Regarding claim 18, claim 18 is drawn to the optical disk drive corresponding to

the method of using the same in claim 3. Therefore, claim 18 contains limitations substantially similar to the limitations of claim 3 and is allowed for the same reasons.

Regarding claim 23, the prior art taken either singularly or in combination fails to anticipate or fairly suggest a medium judgment method which determines authorization of a rewritable storage medium having a read-only area and a rewritable area for use in an optical disk drive, the method comprising steps of: acquiring a specific information of the medium from an information reproduction area of the read-only area of the medium; determining whether contents of the medium are authorized based on the acquired specific information; permitting running of a starting process of the optical disk drive with the medium when the authorization of the medium is determined as being correct; and inhibiting running of the starting process of the optical disk drive with the medium when the authorization of the medium is determined as being incorrect, and ***wherein the method is used to read the rewritable storage medium in a read-only optical disk drive, and when the acquisition of the specific information from the medium is impossible, the medium is determined to be authorized based on an error code indicating that a READ TOC command is an illegal request.***

Regarding claim 24, claim 24 has been rewritten into independent form and contains the allowable subject matter indicated in the Office action dated 12/20/07.

Dependent claims 5, 10, 20-22, and 25-26 are allowed with their respective base claims.



### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Tosaki et al. (US PgPub 2002/0159360) discloses an optical disk and recording method for optical disk. Inchalik et al. (US PgPub 2003/0002671) discloses delivery of electronic content over a network using a hybrid optical disk for authentication. Teramoto (US PgPub 2002/0006094) discloses a recording medium reproduction apparatus. Sako et al. (US PgPub 2003/0174605) discloses a data recording medium. Vasic et al. (US 5,963,536) discloses copy count protection structure for an optical recording medium. Bae (US PgPub 2003/0145181) discloses an optical recording medium preventing illegal duplication. (US Akiyama et al (US 6,414,922) disclose an optical recording medium having an area for recording a plurality of recording/reproduction conditions to be used in recording/reproducing apparatuses. Konishi et al. (US 6,285,638) disclose a disk and disk recording apparatus with playback prevention means. Muramatsu et al. (US 5,926,453) disclose an optical disk having first and second recording areas with wobble frequencies that do not interfere with an EFM signal.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to THOMAS D. ALUNKAL whose telephone number is (571)270-1127. The examiner can normally be reached on M-F 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wayne Young can be reached on (571)272-7582. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Thomas D Alunkal/  
Examiner, Art Unit 2627

/Wayne Young/  
Supervisory Patent Examiner, Art Unit 2627